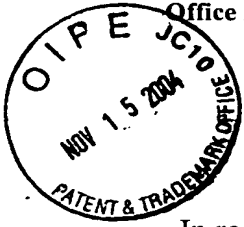


DOCKET NO.: MSFT-0180/138333.1
Application No.: 09/671,055
Office Action Dated: July 30, 2004

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Vijay K. Gajjala et al.

Confirmation No.: **7632**

Application No.: **09/671,055**

Group Art Unit: **3621**

Filing Date: **September 28, 2000**

Examiner: **Reagan, James A.**

For: **Retail Transactions Involving Digital Content In A Digital Rights Management (DRM) System**

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Commissioner for Patents
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Sir:

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REPLY PURSUANT TO 37 CFR § 1.111

In response to the Official Action dated **July 30, 2004**, reconsideration is respectfully requested in view of the amendments and/or remarks as indicated below:

- ☐ **Amendments to the Specification** begin on page _____ of this paper.
- ☐ **Amendments to the Claims** are reflected in the listing of the claims which begins on page _____ of this paper.
- ☐ **Amendments to the Drawings** begin on page _____ of this paper and include an attached replacement sheet.
- ☒ **Remarks** begin on page 2 of this paper.

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REQUEST FOR RECONSIDERATION

The following Request For Reconsideration is submitted in response to the Office Action mailed July 30, 2004 (Paper No. 15) in connection with the above-identified application and is being filed within the three-month shortened statutory period set for a response by the Office Action.

Claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 are pending in the present application. No claim amendments are currently presented, although all claims stand rejected under the Office Action. Applicants respectfully request reconsideration and withdrawal of the rejection of the claims consistent with the following remarks.

The Examiner has once more rejected claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 under 35 USC § 103(a) as being obvious over Stefik et al. (U.S. Patent No. 5,634,012) in view of Ginter et al. (U.S. Patent No. 5,892,900) and further in view of Biddle et al. (U.S. Patent Application Publication No. 2002/0107809). Applicants again respectfully traverse the § 103(a) rejection.

As was previously pointed out, independent claim 1 recites a method for a retailer to facilitate issuance of a digital license from a licensor to a customer for a corresponding piece of digital content. In the method, the retailer receives from the customer payment for the license, where the payment is to be shared with the licensor in a pre-determined manner. The retailer obtains from the customer customer-based information and composes an actual license request, which includes the obtained customer-based information and retailer-based information identifying the retailer to the licensor and acknowledging to the licensor that the retailer owes a portion of the received payment to the licensor. The retailer then forwards to the licensor the actual license request.

In addition, claim 1 recites that the customer has a digital rights management (DRM) system to ensure that the content is rendered in accordance with the license. To obtain the customer-based information, then, the retailer delivers to the customer a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer, and also delivers to the customer a controller that can control the DRM system of the customer. Such controller directs such DRM system to send a dummy license request for a license for the dummy package, where the dummy license request is directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package. The retailer then receives at the interposing site from the customer the dummy license request including customer-based information. Accordingly, composing the actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information.

Independent claim 23 as amended recites similar subject matter to that of claim 1, although in terms of a computer, and independent claim 45 as amended also recites similar subject matter to that of claim 1 as amended, although in terms of a computer-readable medium.

The Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are stored and accessed from such repositories, and are transferred only between such repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., a license with license terms) are attached to digital works in the Stefik

system, and both the work and its attached license are transmitted from a serving repository (at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a license separate from a digital work, as is incumbent in the claims of the present application.

The Ginter reference discloses a system for electronic commerce where content is securely transmitted and rendered in a rights-enforced manner. Generally, in the Ginter reference, secure subsystems of computers or the like provide a distributed virtual distribution environment (VDE) that enforce a secure chain of handling and control of protected digital content. Thus, the Ginter reference discloses employing such a VDE to store, disseminate, and protect content while still ensuring that such content is in secure, protected environments established at each node within the VDE.

The Biddle reference discloses a system for managing licensing data where a distributor 25 and a vendor 40 work together to distribute software to a user 30. However, Applicants after having reviewed the disclosure of the Biddle reference can find no disclosure or suggestion that the Biddle reference discloses a retailer that receives from a customer payment for a license, where the payment is to be shared with a licensor in a pre-determined manner, as is required by the claims of the present application.

As set forth in the Office Action, and according to the Examiner, the limitations of:

the customer having a digital rights management (DRM) system to ensure that the content is rendered in accordance with the license, wherein obtaining the customer-based information comprises:

delivering, by the retailer to the customer, a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer;

delivering, by the retailer to the customer, a controller that can control the DRM system of the customer, wherein such controller directs such DRM system to send a

dummy license request for a license for the dummy package, the dummy license request being directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package; and

receiving, by the retailer at the interposing site from the customer, the dummy license request including customer-based information, and wherein composing the actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information

are all made obvious by the Stefik reference, at least based on the passage at column 48, lines 29-67, because such passage discloses demo versions and upgrading digital works that can be read as the 'dummy license' of the present invention. However, and significantly, the present invention does not deal with a 'dummy license', but instead sets forth a dummy package with license acquisition information therein from which a dummy license request is generated. As may be appreciated from the specification of the present application, the dummy license request is intercepted and converted into an actual license request from which is obtained an actual license for actual content, but such actual content is acquired later inasmuch as such dummy package in fact has no such actual content.

Nevertheless, the passage cited to by the Examiner is reproduced herein:

Demo Versions

A creator believes that if people try his work that they will want to buy it or use it. Consumers of his work can copy the work for free, and play (or execute) a limited version of the work for free, and can play or use the full featured version for a fee.

This scenario is performed as follows:

The creator creates a digital work and grants various rights and fees. The creator grants Copy and Embed rights without a fee, in order to ensure widespread distribution of the work. Another of the rights is a limited play right with little or no fee attached. For example, this right may be for playing only a portion of the work. The play right can have various restrictions on its use. It could have a ticket that limits the number of times it is used. It could have internal restrictions that limit its functionality. It could have time restrictions that invalidate the right after a period of time or a period of use. Different fees could be associated with other versions of the Play right.

Upgrading a Digital Work with a Vendor

A consumer buys a digital work together with an agreement that he can upgrade to a new version at a later date for a modest fee, much less than the usual purchase price. When the new version becomes available, he goes to a qualified vendor to make the transaction.

This scenario deals with a common situation in computer software. It shows how a purchase may include future "rights." Two important features of the scenario are that the transaction must take place at a qualified vendor, and that the transaction can be done only once per copy of the digital work purchased.

This scenario is performed as follows:

The creator creates a digital work, an upgrade ticket, and a distribution license. The upgrade ticket uses the a generic ticket agent that comes with repositories. As usual, the distribution license does not have Copy or Transfer rights. He distributes a bundled copies of the work and the ticket to his distributors as well as distribution licenses.

The distributor sells the old bundled work and ticket to customers.

The customer extracts the work and the ticket. He uses the work according to the agreements until the new version becomes available. When the new work is ready, the creator gives it to distributors. The new work has a free right to copy from a distributor if a ticket is available.

The consumer goes to distributors and arranges to copy the work. The transaction offers the ticket. The distributor's repository punches the ticket and copies the new version to the consumers repository.

The consumer can now use the new version of the work.

Applicants respectfully submit that a fair reading of the specification of the present application should make clear that the dummy package in the claims is not akin to a "demo version", such as that employed in the Stefik reference and set forth above. In particular, it should be clear from the above passage that the Stefik "demo version" is in fact a version of a digital work (i.e., a piece of content), with a less-than-full set of rights attached (i.e., a

restricted license for use), where the demo version may presumably be upgraded at some point.

In contrast, and as was set forth above, the dummy package of the present invention as set forth in the claims includes no actual content, but instead is a token with license acquisition information based on which an actual license for such actual content may be acquired. Even though the dummy package does not have such actual content, such dummy package is representative of such actual content, and such actual content may in fact be obtained at a later time.

At any rate, Applicants respectfully submit that the limitations of claims 1, 23, and 45 as set forth above cannot be considered to be made obvious by the passage of the Stefik reference set forth above. In particular, even though Stefik does disclose a demo version of content that can be upgraded, such disclosure cannot be said to make obvious all of:

the customer having a digital rights management (DRM) system to ensure that the content is rendered in accordance with the license, wherein obtaining the customer-based information comprises:

delivering, by the retailer to the customer, a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer;

delivering, by the retailer to the customer, a controller that can control the DRM system of the customer, wherein such controller directs such DRM system to send a dummy license request for a license for the dummy package, the dummy license request being directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package; and

receiving, by the retailer at the interposing site from the customer, the dummy license request including customer-based information, and wherein composing the actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information,

not least of which because of the share amount of claim language that would supposedly be obvious based on such Stefik passage. Moreover, and at any rate, Applicants respectfully

submit that the Stefik reference does not disclose or suggest in connection with such upgradeable demo version that a retailer deliver to a customer a dummy package with license acquisition information containing a site identifier for an interposing site controlled by the retailer, that the retailer deliver to the customer the recited controller, or that the retailer at an interposing site composes an actual license request based on the dummy license request by modifying the dummy license request to add the retailer-based information, all as required by claims 1, 23, and 45.

Once again, Applicants respectfully submit that none of the cited references provides any disclosure or suggestion that in connection with a retailer providing a license to a customer, the retailer delivers to the customer a dummy package having license acquisition information containing a site identifier for an interposing site controlled by the retailer, and also delivers to the customer a controller that can control the DRM system of the customer, as is required by claims 1, 23, and 45; that such controller directs such DRM system to send a dummy license request for a license for the dummy package, where the dummy license request is directed to the site identifier for the interposing site controlled by the retailer according to the license acquisition information in the dummy package, as is also required by claims 1, 23, and 45, and that the retailer then receives at the interposing site from the customer the dummy license request including customer-based information, as is further required by claims 1, 23, and 45. Thus, such Stefik, Ginter, and Biddle references also do not disclose that composing an actual license request comprises modifying, by the retailer, the dummy license request to add the retailer-based information, as is additionally required by claims 1, 23, and 45.

Moreover, after reviewing each of the aforementioned, Stefik, Ginter, and Biddle references, Applicants can find no suggestion or teaching in any of such references that would provoke one skilled in the art to combine the entirety of the teachings of such references to result in the present invention as recited in such claims 1, 23, and 45.

Applicants note that the Examiner has again requested in the Office Action that Applicants consider fully the entire references, as if to suggest that the specific rationales for the assertion of obviousness may somehow be conjured from the entirety of such references. However, and again, Applicants respectfully submit that it is the Examiner's responsibility to make a prima facie case for obviousness under Section 103, and not the Applicants' responsibility to somehow glean from the entirety of the cited references what might possibly be intended.

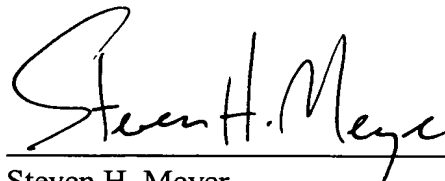
At any rate, Applicants again respectfully submit that none of the Stefik, Ginter, and Biddle references discloses or suggests the invention recited in claims 1, 23, and 45, or any claims depending therefrom. For all of the aforementioned reasons, then, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

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In view of the foregoing discussion, Applicants respectfully submit that the present application including claims 1-3, 5-15, 23-25, 27-37, 45-47, and 49-59 is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Steven H. Meyer". The signature is written in a cursive style with a horizontal line underneath it.

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Date: November 15, 2004

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